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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,872	12/16/2003	Akiko Sato	NITT.0168	5448
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REED SMITH LLP 3110 FAIRVIEW PARK DRIVE, SUITE 1400 FALLS CHURCH, VA 22042			EXAMINER RANKINS, WILLIAM E	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/735,872

Applicant(s)

SATO ET AL.

Examiner

WILLIAM E. RANKINS

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)
Paper No(s)/Mail Date 08/06/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 08/06/2008 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Status of Claims

Claims 1-32 are pending in this application. Claims 1-13 have been canceled and claims 14-32 are new.

Response to Arguments

1. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

A review of the claims and updated search necessitated the rejections below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 25-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In the present case, the claims are not tied to another statutory class such as an apparatus. Based on Supreme Court precedent (*Diamond V. Diehr*, 450 U.S. 175,184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) a 101 process must be tied to another statutory class or transform underlying subject matter to a different stat or thing, If neither of these requirements is met by the claim, the method is not a patent eligible process under 101 and should be rejected as being directed to non-statutory subject matter.

2. Claims 27-32 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap *two* different statutory

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classes of invention as set forth in 35 USC 101. In the present case, the dependent claims are directed toward a system but are dependent upon a method claim. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. See MPEP 2173.05(p) section II.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 14-16, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oneda (6,213,390) in view of Kawajiri (JP 62131371A).

As per claim 14;

Oneda discloses:

A credit settlement system comprising:

a bank service provider system (Fig. 2, 16-1 and Col. 3, lines 48-51);

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a credit service provider system (Fig. 13, POS host system, Col. 12, lines 11-25); and

a smart card (Fig. 2, 30),

wherein a bank account for pool established by the bank service provider system is configured to receive a user's deposit (Col. 1, lines 29-65),

wherein the bank service provider system is configured to issue a token, which contains an amount of the user's deposit in the bank account for pool, to certify a receipt of the user's deposit and transmit the token to the smart card, and the smart card is configured to store the token (Col. 18, lines 25-33), and

Oneda does not disclose:

wherein the credit service provider system is configured to extract the token from the smart card and to update a user's financial state and credit limit stored in a financial status database of the credit service provider system according to the amount of the user's deposit, when the smart card is used for a credit service.

However, Kawajiri discloses:

Transferring money from an account to an IC card shopping account and transmitting the amount, data of accounts and shopping read out to a center file.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Oneda and Kawajiri. One of ordinary skill in the art at the time of this invention would have been motivated to do so as each claimed element is disclosed and well known in the prior art.

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When combining the references the function of the individual elements remains unchanged. See MPEP 2141, III (A).

As per claim 15;

Oneda discloses:

The credit settlement system according to claim 14, wherein the credit service provider system is configured to compare a sum of a requested credit transaction with the updated credit limit, and to present a result of the comparison to the user (Col. 9, lines 21-43).

As per claim 16;

Oneda does not disclose:

The credit settlement system according to claim 14, wherein once the user deposits money in the bank account for pool, the user is unable to withdraw money from the bank account for pool.

However, the examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention that a user would not be able to withdraw money from an account that was not the users without the direct use of the IC card to which the account is connected.

As per claim 21;

Oneda does not specifically disclose:

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The credit settlement system according to claim 14, wherein the credit service provider system updates a user's financial state and credit limit by temporarily reflecting the amount of the user's deposit in the user's credit limit.

However, Oneda discloses:

A withdrawal to an IC card being reflected in the bank account of the card issuer (pool account) at the same time (abstract).

The examiner asserts that the problem being solved is the same, as is disclosed by the applicant in Para. 0017 of the summary of invention.

As per claim 22;

Oneda does not specifically disclose:

The credit settlement system according to claim 14, wherein the credit service provider system updates a user's financial state and credit limit by immediately reflecting the amount of the user's deposit in the user's credit limit.

However, Oneda discloses:

Immediately reflecting the deposit to the IC card in the account of the retail trade and effecting the realization of consumer services (Col. 6, lines 5-22).

Claim 25 is rejected under the same rationale used to reject claim 14.

Claim 26 is rejected under the same rationale used to reject claim 15.

Claim 27 is rejected under the same rationale used to reject claim 16.

Claim 29 is rejected under the same rationale used to reject claim 21.

Claim 30 is rejected under the same rationale used to reject claim 22.

2. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oneda (6,213,390) in view of Kardos et al. (6,345,281), Saliba et al. (2002/0065772), Choi et al. (2003/0220884), Blakley, et al. (2004/0128546), Mirilas et al. (2002/0174075) and Baker et al. (EP 623902 A2).

As per claim 17;

Oneda discloses:

The credit settlement system according to claim 14, wherein the token comprises the amount of the deposit, a date of the deposit, a bank ID and a bank account number (col. 3, lines 1-3).

Oneda does not disclose:

The credit settlement system according to claim 14, wherein the token comprises a user's name, a user ID, a token ID, an expiration date of the token, a bank account number, a credit card company ID, and a credit card number.

However, the examiner asserts that tokens, messages, keys and the like used in the transmission of information were well known in the art at the time of this invention, e.g.

Kardos discloses:

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Messages containing a unique message ID, and a date/time stamp (Col. 11, lines 15-33). The system of Kardos allows the token or message to be received by a universal receptor for messages from any and all host systems.

Saliba discloses:

A token comprising a user ID and expiration date (Claim 39).

Choi discloses:

A deposit request message containing a subscriber bank account, bank and amount information (Para. 0139).

Blakley discloses:

A token containing the user's name (Para. 0172).

Mirlas discloses:

A payment message containing the credit card number (Para. 0127). The examiner asserts that the credit card company ID is contained within the credit card number as it was well known in the art at the time of this invention that the first digit of a credit card number is reserved for particular credit card companies like MC, Visa, Amex, etc.

Additionally, Baker discloses;

A smart card that receives funding from a credit card (Col. 5, lines 40-53) and an authorization message that includes an identification number or an account number, the amount of recharge and control data stored on the smart card (Col. 6, lines 17-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Oneda, Kardos, Saliba, Choi, Blakley, Mirlas and Baker.

According to KSR exemplary rationale E, it would be obvious to try when choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success. Because of pooled accounts, tokens or messages will need to be uniquely identified in order to be properly credited.

3. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oneda (6,213,390) in view of Baker et al. (EP 623903 A2).

As per claim 18;

Oneda does not disclose:

Baker discloses:

The credit settlement system according to claim 14, wherein the financial status database stores the user's credit line and outstanding liability (Col. 3, lines 8-11). The examiner asserts that a balance is the result of the comparison of a credit line with a liability.

Claim 28 is rejected under the same rationale used to reject claim 18.

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oneda (6,213,390) in view of Hogan (5,557,516).

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As per claim 19;

Oneda discloses:

The credit settlement system according to claim 14, wherein the bank service provider system manages user information, account information, and usual banking functions including processing of deposits in and withdrawals from users' accounts and automatic transfers money in and out (Col. 1, lines 44-49).

Oneda does not disclose:

Automatic transfers of money in and out.

However, Hogan discloses:

An automatic renewal feature (abstract) and an automatic refund to the user's card (Col. 6, lines 15 and 16).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Oneda and Hogan. One of ordinary skill in the art at the time of this invention would have been motivated to do so as a convenience to the customer.

5. Claims 20 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oneda (6,213,390) in view of Official Notice.

As per claim 20;

Oneda does not disclose:

The credit settlement system according to claim 14, wherein the credit service provider system performs credit service functions including managements of user information and credit card information, financial status confirmation and payment processing.

However, Official Notice is taken that it is old and well known in the art to use a credit service provider, otherwise known as "processors". (See Ingram et al., 2003/0033249).

As per claim 23;

Oneda does not disclose:

The credit settlement system according to claim 14, wherein the amount of the user's deposit is made into the bank account for pool not later than a prescribed due day to pay the amount of the user's deposit to the credit service provider system, and the bank service provider system withdraws the amount of the user's deposit from the bank account for pool to pay to the credit service provider system on the due day.

However, Official Notice is taken that automatic payments from an IC card are old and well known to those of ordinary skill in the art at the time of this invention. (See Yoshida, 5,144,115, Col. 5, lines 28-60).

Claim 24 is rejected under the same rationale used to reject claim 23.

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Claim 31 is rejected under the same rationale used to reject claim 23.

Claim 32 is rejected under the same rationale used to reject claim 24.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William E Rankins/
Examiner, Art Unit 3696
09/14/2008

/Daniel S Felten/
Primary Examiner, Art Unit 3696